

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

**BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,846	07/16/2001	Eldar Tuvey	9578-001-27	2802

7590 08/19/2004

Supervisor, Patent Prosecution Services  
PIPER MARBURY RUDNICK & WOLFE LLP  
1200 Nineteenth Street, N.W.  
Washington, DC 20036-2412

EXAMINER

STRANGE, AARON N

ART UNIT PAPER NUMBER

2153

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/904,846

Applicant(s)

TUVEY ET AL.

Examiner

Aaron Strange

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02272002,08082008.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because the drawings are of poor quality and difficult to read. Some of the labels are so small that the text cannot be determined. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claims 1,2,7 and 16 are objected to because of the following informalities:

3. With regard to claim 1, there appears to be a typographical error "according instructions" in line 8. The Office recommends that the claim be amended to recite "according to instructions".
4. With regard to claim 2, there appears to be a typographical error "comprise one or more textual" in lines 1-2. The Office recommends that the claim be amended to recite "comprises one or more of: textual".
5. With regard to claim 7, there appears to be a typographical error "from sending" in line 2. The Office recommends that the claim be amended to recite "from the sending".
6. With regard to claim 16, there appears to be a typographical error "according to claim 1, comprising" in line 1. The Office recommends that the claim be amended to recite "according to claim 1, further comprising".
7. With further regard to claim 16, there appears to be a typographical error "identify" in line 1. The Office recommends that the claim be amended to recite "identity".
8. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
10. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter

Art Unit: 2153

which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

11. With regard to claim 20, the "electronic processing engine", which is a software program per se, cannot form part of a transmission path for a network communication. Network communications must travel over physical hardware. For the purpose of applying prior art, this claim has been interpreted such that a computer running the engine forms part of the transmission path for the communication.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1,3, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claim 1 recites the limitation "the electronic network communication" in line 3 and "the network communication" in line 5. There is insufficient antecedent basis for these limitations in the claim. For the purpose of applying prior art, it has been interpreted that both of these phrases refer to the "electronic communication" claimed in line 1.

15. Claim 3 recites the limitation "the communications are" in line 2. There is insufficient antecedent basis for this limitation in the claim. Only a single communication appears to be claimed in claim 1. The Office recommends that the claim be amended to recite "the communication is".

Art Unit: 2153

16. Claim 14 recites the limitation "the communications" in line 1. There is insufficient antecedent basis for this limitation in the claim. Only a single communication appears to be claimed in claim 1. The Office recommends that the claim be amended to recite "the communication".

***Claim Rejections - 35 USC § 101***

17. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

18. Claims 18,20, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

19. With regard to claims 18 and 20, Applicant is claiming an "electronic communication processing center engine loadable onto a computer", which is a software program per se and since it is not tangibly embodied on a computer readable medium, it is merely a manipulation of abstract ideas.

20. With regard to claim 21, Applicant is claiming software program per se and since it is not tangibly embodied on a computer readable medium, it is merely a manipulation of abstract ideas.

14. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of Applicant amending these claims to place them within the four statutory categories of invention.

***Claim Rejections - 35 USC § 102***

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. Claims 1-10,12,15 and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldschmitt et al. (WO 96/24213).

23. With regard to claims 1 and 18-22, Goldschmitt et al. (Goldschmitt, hereafter) discloses a method of embedding additional information into an electronic communication transmitted via a network from a sending party to a receiving party comprising the steps of: intercepting the electronic network communication sent by the sending party addressed to the receiving party (Receive mail from sender) (Page 11, Lines 13-14); extracting and sending information relating to the network communication to a remote server (Extract and store user-specific information) (Page 11, Lines 14-19); modifying the network communication to embed the additional information in the network communication according instructions and information provided by the remote server in response to the information sent to the remote server (attach advertisement to email) (Page 12, Lines 20-22); and transmitting the modified network communication to the receiving party (Page 12, Lines 22-23).



With regard to claims 18-22, the limitations not explicitly rejected with regard to claim 1 are inherent to the system disclosed by Goldschmitt. Since Goldschmitt discloses that the system operates on a plurality of computers, computer software, stored on a computer readable medium, and capable of operating the system, is required.

24. With regard to claim 2, Goldschmitt further discloses that the additional information comprises one or more of: textual content, graphical content, links to other information, audio content and visual content Page 10, Line 28 to Page 11, Line 2).

25. With regard to claim 3, Goldschmitt further discloses that the remote server is located on the same physical device on which the communications are intercepted (Part of email messaging center) (Page 8, Lines 9-13).

26. With regard to claim 4, Goldschmitt further discloses that the remote server generates the instructions and information for modifying the communication by employing an algorithm running on the remote server that combines the information extracted from the communication with one or more rules, other information, historical data or a combination of these (User-specific data from the communication is combined with other information such as time of day) (Page 11, Line 14 to Page 12, Line 1).

27. With regard to claim 5, Goldschmitt further discloses that the algorithm applies the same generic rules to all communications (General environmental and system environmental rules apply to all communications) (Page 11, Line 24 to Page 12, Line 23).

Art Unit: 2153

28. With regard to claim 6, Goldschmitt further discloses that different rules are applied to different individual senders and/or recipients or groups of senders and/or recipients (User specific information is used to determine information to append) (Page 11, Lines 14-16).

29. With regard to claim 7, Goldschmitt further discloses that the communication is intercepted and modified at a device that is physically remote from sending party and receiving party (email messaging center) (Page 8, Lines 9-13).

30. With regard to claim 8, Goldschmitt further discloses that the additional information is advertising material (Page 12, Lines 20-22).

31. With regard to claim 9, Goldschmitt further discloses that the additional information is reference information (Page 9, Lines 23-26).

32. With regard to claim 10, Goldschmitt further discloses that the intercepted communication is an email (Page 11, Lines 13-14).

33. With regard to claim 12, Goldschmitt further discloses that the content of the additional information embedded in the communication is determined at least in part on preference data held for one or both of the sending party and receiving party (consumer preferences) (Page 11, Lines 17-19).

34. With regard to claim 15, Goldschmitt further discloses that the additional information comprises a reference to further information content it is intended be displayed within the message (Page 9, Line 23 to Page 10, Line 5).

***Claim Rejections - 35 USC § 103***

35. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

36. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt et al. (WO 96/24213) in view of Gupta et al. (6,487,538).

37. With regard to claim 11, while the system disclosed by Goldschmitt shows substantial features of the claimed invention (discussed above), including that the content of the additional information embedded in the communication is determined based at least in part on historical data held about the sending party (sender's location, etc) (Page 11, Lines 17-19), it fails to disclose using historical data about the receiving party.

Gupta et al. (Gupta, hereafter) discloses a similar system for inserting advertisements in data transmitted from a web host to a client. Gupta teaches that the advertising data embedded in the communication is based in part on historical data about the receiver, particularly a history of the advertisements previously seen (Col 12, Lines 11-14). This prevents a recipient from receiving the same advertisement repeatedly. Exposing the receivers to a plurality of advertisements increases the chances that a product displayed will be of interest

Art Unit: 2153

to the recipient. This will increase the chances that a recipient will make a purchase of the item, increasing revenue for both the advertiser and the email provider.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to record historical information about the recipient such as the advertisements previously viewed. This would have prevented the same advertisement from being repeatedly shown to a since recipient. Increasing the variety of advertisements viewed by the recipient will increase the chances that an advertisement will be displayed that the recipient is interested in.

38. With regard to claim 13, while the system disclosed by Goldschmitt shows substantial features of the claimed invention (discussed above), it fails to disclose that the preference data comprises the communication format capabilities of the receiver party.

Gupta discloses a similar system for inserting advertisements in data transmitted from a web host to a client. Gupta teaches that user preferences include information regarding the format capabilities of the receiver (Col 12, Lines 14-22). This prevents graphical advertisements from being transmitted when the user only has the capability to display textual advertisements. This is particularly advantageous since many browsers such as cellular phone browsers can only display limited graphics compared to a conventional PC browser.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to record preference data for the sender and/or

Art Unit: 2153

receiver regarding the communication format capabilities of the receiver. This allows the receiver to specify the types of advertisements that can be displayed in the receiver's browser. Since some browsers have limited graphical display capabilities, this prevents graphical advertisements from being sent to these users.

39. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt et al. (WO 96/24213).

40. With regard to claim 14, while the system disclosed by Goldschmitt shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the interception of the communications can be controlled remotely.

However, remote control of servers is well-known in the art and updating settings over a remote network connection is very common. This allows settings on a computer to be changed without requiring the administrator to physically go to the machine to be updated. This is particularly advantageous for administrators of large systems containing many servers such as the on-line service providers disclosed by Goldschmitt (Page 2, Lines 20-22), and would almost certainly be present in the system disclosed by Goldschmitt.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow remote control of the email messaging center since it allows settings related to the display of advertisements, such as a new advertiser, to be modified without requiring the administrator to travel to the

physical location of the server. This is a well-known method of updating settings on a network-connected computer, and would be an advantageous addition to the system disclosed by Goldschmitt.

41. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt et al. (WO 96/24213) in view of Madison (US 2002/0023123).

42. With regard to claim 16, while the system disclosed by Goldschmitt shows substantial features of the claimed invention (discussed above), it fails to disclose remotely detecting the identity of the ISP hosting a receiving party or a sending party.

Goldschmitt discloses determining the location of the user, but fails to disclose how this is accomplished (Page 11, Lines 17-19). Madison teaches a method of determining the location of a user by remotely detecting the ISP hosting the user. This allows specific information about the location of the user to be ascertained based on the user's ISP. The phone number used for dial-up access is obtained and compared to a database to determine the user's ISP and further information including zip code, city, and state where the user is located. This information can then be used to generate demographic information regarding the user (Paragraph 32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to identify the ISP hosting the sender and/or

Art Unit: 2153

receiving parties to enable detailed demographic information such as city, state, and zip code to be determined for the users of the system.

43. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt et al. (WO 96/24213) in view of Cisco.com.

44. With regard to claim 17, while the system disclosed by Goldschmitt shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the communication is addressed to multiple receiving parties, the method further comprising replicating the communication to create a separate instance of the communication for each of the receiving parties.

Cisco discloses SMTP, a conventional email transmission protocol. Cisco discloses that SMTP creates a separate data set for each recipient and carbon copy email address (Page 5, Lines 27-29). This is necessary since recipients can be located on multiple different hosts, and messages can only be transmitted to one host at a time. This allows the user to specify recipients on multiple hosts to receive a single message.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replicate the communication when sending a message to multiple recipients via email. This is required in order to send a message to multiple recipients located on different hosts, which would be an advantageous feature, since it would be very inconvenient for the sender to have to manually send a message to each host that serves a desired recipient.

**Conclusion**

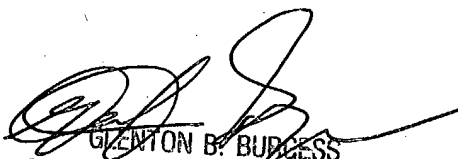
45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 703-305-8878. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ANS 8/9/2004

  
GLEN B. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100